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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,363	11/01/2001	Ali Bani-Hashemi	2001P18496US	7290

7590

11/25/2003

Siemens Corporation  
Attn: Elsa Keller, Legal Administrator  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 11/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/004,363

Applicant(s)

BANI-HASHEMI ET AL.

Examiner

Eleni Mantis Mercader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,535,574. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings.

3. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/051,588. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Cosman'072.

Regarding claims 1 and 17, Cosman'072 teaches a method comprising:

acquiring first data representing a three-dimensional surface of at least a portion of a patient's body while the patient is in a first position (col. 3, lines 34-39; col. 4, lines 13-24; col. 4, lines 35-47; describing how the cameras track in a three-dimensional space the surface of the patient marked by trackable markers and also see col. 16, lines 8-42, describing video views and also see col. 18, lines 34-40; describing 3D surface contour matching);

and acquiring second data representing at least one internal portion of the patient's body while the patient is in the first position (col. 3, lines 29-34).

Regarding claims 2, 14, and 18 Cosman'072 teaches determining a radiation treatment plan based on the first data, the second data, and on data representing a physical layout of a radiation treatment station and a treatment planning device for generating a radiation treatment plan based on the computed tomography data, the first

three-dimensional surface data, and data representing a physical layout of a radiation treatment station (see col. 4, lines 48-61 and col. 5, lines 8-45).

Regarding claim 3, Cosman'072 teaches determining the radiation treatment plan comprising: determining a position of a radiation treatment device that will avoid the patient's body and that will allow irradiation of a portion of the at least one internal portion (see col. 7, lines 18-24).

Regarding claims 4-5, 12, and 19 Cosman'072 teaches, the first position being a position that is substantially maintained during a computed tomography scan (see col. 10, lines 19-37), and comparing the CT information with the camera information to determine whether the positional information matches (see col. 10, lines 37-50).

Regarding claim 6, Cosman'072 teaches moving the patient so that the second position corresponds to the first position (see col. 10, lines 50-57 and see col. 13, lines 29-42).

Regarding claim 7, Cosman'072 teaches changing a radiation treatment plan for the patient based on a difference between the first position and the second position (see col. 6, lines 39-59).

With respect to claims 8-11 and 20-23 any movements outside of acceptable thresholds or otherwise stated outside of the body boundaries, are detected and corrections are made by moving the patient's body in order to deliver effective treatment (col. 16, lines 60-67 and col. 17, lines 1-48).

Regarding claim 13, Cosman'072 teaches a computed tomography scanning device for acquiring computed tomography data of a patient while the patient is in a scanning position (col. 20, lines 28-31); and a first surface photogrammetry device for

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acquiring first three-dimensional surface data of at least a portion of the patient's body while the patient is in the scanning position (col. 20, lines 36-41 and 47-52 and col. 18, lines 34-40).

With respect to claim 15, Cosman'072 further teaches a controller for determining if the treatment position corresponds to the scanning position based on the first three-dimensional surface data and the second three-dimensional surface data (see col. 6, lines 50-59 and col. 10, lines 37-50).

Regarding claim 16, Cosman'072 further teaches the first surface photogrammetry device and the second surface photogrammetry device are a same device (see alternative embodiments of Figures 5 and 6 wherein either 2 cameras or three cameras are used, so in the embodiment of Figure 11, the function of two cameras is accomplished by a single camera or alternatively stated, two cameras are used as opposed to three).

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schweikard et al.'981 teach an apparatus and a method for compensating for respiratory and patient motions during treatment.

Kendrick et al.'614 teach a method and an apparatus for alignment of medical radiation beams using a body frame.

Cosman et al.'900 teach a head band for frameless stereotactic registration.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on 703 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.



Eleni Mantis Mercader  
Primary Examiner  
Art Unit 3737

EMM